

REMARKS

These remarks are in response to the non-final Office Action mailed January 24, 2006, in which claims 1-5 are pending. Claims 1-5 stand rejected.

The Applicants provide the following remarks in response to the Examiner's rejections of the claims.

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,523,081 to Edwards (hereinafter "the '081 patent") in view of U.S. Patent No. 5,985,299 to Buerger et al. (hereinafter "the '299 patent")

In making the above rejection, The Examiner alleges that the '081 patent teaches all the limitations of claim 1 except the use of dichlorobenzyl alcohol. The Examiner further alleges that the '299 reference teaches use of dichlorobenzyl alcohol at a concentration from 0-2%, more preferable from 0-1% and most preferably around 0.5% by weight. The Examiner concludes that it would have been obvious for one of ordinary skill in the relevant art to combine the teachings of the '081 and '299 references and utilize dichlorobenzyl alcohol as the preservative. (See generally, the Office Action of January 24, 2006, pp. 2-4).

The Applicants disagree with the Examiner's position. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." See MPEP 2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). And, when reviewing the prior art, each "... reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." See MPEP 2141.02 (*citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Claim 1 recites a shaving composition comprising from about 40% to about 90% by weight of water, from about 4% to about 25% by weight of water-soluble soap, from about 0.5% to about 12% by weight of an inert volatile liquid agent, and from 0.1% to about 5.00% of dichlorobenzyl alcohol.

The '081 reference is directed to a cosmetic composition for shaving products. The cosmetic composition is in aerosol or post-foaming gel form comprising water, soap, an inert volatile liquid agent, optionally a gelling agent, and a polyorganosiloxane micro-emulsion having an average particle size of less than 0.14 microns. The cosmetic composition comprises from 40-90% by weight of water, from 4-25% by weight of water-soluble soap,

from 0.5-12% by weight of an inert volatile liquid agent and optionally from 0.0105% by weight of a water-soluble gelling agent. The composition further includes from 0.01-15% by weight polyorganosiloxane micro-emulsion.

The '299 reference pertains to a cosmetic pore cleaning product for treatment of skin including the removal of keratotic plugs from the pores of skin. The cosmetic pore cleaning products are comprised of formulations including non-ionic, film-forming, solvent-activatable polymers. The formulations include N-vinyl formamide as in poly (N-vinyl formamide). The 2% by weight, more preferable from 0.1.0% by weight and most preferably 0.5% by weight. The products are used to remove keratotic plugs by applying the product to the skin, allowing product to dry, and peeling the product from the skin.

Unlike claim 1 of the present application, the '299 reference does not teach or suggest a shaving composition comprising from 0.1% to about 5.00% dichlorobenzyl alcohol. Instead, the '299 reference describes the use of dichlorobenzyl alcohol for stabilizing the composition and/or preventing the growth of bacteria and/or molds therein.

In fact, the '299 reference teaches away from being combined with the '081 reference. In particular, while the '081 reference discloses a shaving composition that the Examiner admits does not specify a use of dichlorobenzyl alcohol, the '299 reference discloses a film-forming composition that, when applied to skin and dried, is peeled from the skin to remove keratotic plugs. The dichlorobenzyl alcohol in the composition of the '299 reference appears to be only for stabilizing the composition and/or preventing the growth of mold and/or bacteria. One of skill in the art would not look to the teaching of the '299 reference (i.e., a composition that is applied to the skin and dried) when looking to modify the '081 reference (i.e., a shaving composition without dichlorobenzyl alcohol that is applied and removed during a normal shaving process). The differences between the two types of compositions are significant, with the '299 being a type of composition that would, in fact, make shaving more difficult. The two applications are, therefore, drawn to art fields that are mutually exclusive of each other.

Accordingly, because the '081 and '299 references do not individually teach or suggest the invention as recited in claim 1, and because they are not properly combinable, it is asserted that the cited prior art does not render the present invention, as recited in claim 1, obvious. Favorable reconsideration of the rejection of claim 1 is requested.

Claims 2-5 depend from claim 1 and are therefore allowable over the cited prior art for at least the same reasons mentioned above, as well as by virtue of the additional

recitations included therein. Favorable reconsideration of the rejection of these claims is also requested.

Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '081 patent in view of U.S. Patent No. 5,523,017 to Moran et al. (hereinafter "the '017 patent")

In making the above rejection, the Examiner alleges that the '081 reference teaches all the limitations of claim 1 except the use of didlorobenzyl alcohol. The Examiner further alleges that the '017 reference teaches use of dichlorobenzyl alcohol in solid cleansing bars including shaving bars at a concentration from 0.2% to 0.5%. The Examiner also alleges that the '017 reference teaches the addition of colors, fragrances, medicaments, astringents, deodorants, antidandruff substances, and antibacterial agents in the amount of 0.5-5%. The Examiner concludes that it would have been obvious for one of ordinary skill in the relevant art to combine the teachings of the '081 and '017 references and utilize dichlorobenzyl alcohol as the bactericide. (See generally, the Office Action of January 24, 2006, pp. 4-6).

The Applicants disagree with the Examiner's position. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143." And, when reviewing the prior art, each "... reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." See MPEP 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

The teachings of claim 1 are provided above.

The teachings of the '081 patent are also provided above.

The '017 reference is directed to a solid cleansing bar for use as a shampoo, a skin cleaning bar or a shaving bar. The solid cleansing bar comprises a composition including from 70% to 80% by weight of a polyethylene glycol (PEG) base system having an average molecular weight between 6,500 and 8,500. The base system may comprise a mixture of

PEG 6000, PEG 8000 and PEG 400. The composition includes from 12% to 20% by weight of a detergent which is typically a combination of an anionic surfactant and an amphoteric surfactant. The composition can also include up to 12% coactive ingredients such as foam stabilizers, pearling agents, emollients and conditioners. In addition the composition can include colors, fragrances, deodorants, and antibacterial agents generally in concentrations between 0.5 to 5%, including 0.2-0.5% dichlorobenzyl alcohol.

Unlike claim 1 of the present application, the '017 reference does not teach or suggest a shaving composition comprising 40% to about 90% weight of water, from about 4% to about 25% by weight of water-soluble soap; from about 0.5% to about 12% by weight of an inert volatile liquid agent; and from 0.1% to about 5.00% of dichlorobenzyl alcohol. Instead, the '299 reference describes the use of dichlorobenzyl alcohol in a solid bar which must be solubilized in warm water for use. The Applicants submit that it would not be obvious to one of skill in the art to look to the field of solid bars when looking to modify the '081 reference. In fact, the '081 reference clearly states that it is a composition intended for shaving in aerosol or post-forming gel form. Therefore, the art fields of the two are mutually exclusive and there is no motivation, stated or otherwise, to modify the aerosol or gel formulation of the '081 reference to include ingredients found in a solid bar. In fact, the intended compositions of the two cited references alone would lead one of skill in the art from combining these references.

Accordingly, because the '081 and '017 references do not individually teach or suggest the invention as recited in claim 1, and because they are not properly combinable, it is asserted that the cited prior art does not render the present invention, as recited in claim 1, obvious. Favorable reconsideration of the rejection of claim 1 is requested.

Claims 2-5 depend from claim 1 and are therefore allowable over the cited prior art for at least the same reasons mentioned above, as well as by virtue of the additional recitations included therein. Favorable reconsideration of the rejection of these claims is also requested.

Claim 1 is rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/06153 to Moldovanyi (hereinafter "the Moldovanyi reference") in view of U.S. Patent No. 2,945,782 to Schraufstatter (hereinafter "the '782 patent")

The Examiner alleges that the '153 reference teaches all the limitations of claim 1 except the use of an inert volatile liquid together with dichlorobenzyl alcohol. The Examiner further alleges that the '782 reference teaches use of an inert volatile liquid together with

dichlorobenzyl alcohol. The Examiner concludes that it would have been obvious for one of ordinary skill in the relevant art to combine the teachings of the '153 and '872 references and utilize inert volatile liquids together with dichlorobenzyl alcohol. In support of the rejection, the Examiner states that the term "shaving" has not been given patentable weight because the recitation occurs in the preamble. (See generally, the Office Action of January 24, 2006, pp. 6-8).

The Applicants disagree with the Examiner's position. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." See MPEP 2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). And, when determining what is the claimed invention, the preamble must be considered when it breathes meaning into the claim. See MPEP 2111.02.

The '153 reference relates to surface-active soap formulations, comprising: (a) 0.01 to 5% by weight of a microbiocidal active substance selected from the group consisting of (a1) phenol derivatives (a2) diphenyl compounds (a3) benzyl alcohols (a4) chlorohexidine (a5) C12-C14 alkylbetaines and C8-C18 fatty acid amidoalkylbetaines (a6) amphoteric surfactants, and (a7) trihalocarbanilides; (b) 0.1 to 25% by weight of one or more than one hydrotropic agent; (c) 0 to 10% by weight of one or more than one synthetic surface-active substance or of a soap or a combination thereof; (d) 0 to 8% by weight of a salt of a saturated and/or unsaturated C8-C22 fatty acid; (e) 0 to 50% by weight of a dihydric alcohol; (f) 0 to 70% by weight of a monohydric alcohol or of a mixture of several monohydric alcohols; and (g) water or deionised water to make up 100%. The formulations are used for the disinfection and cleansing of the human skin.

The '782 reference is directed to a disinfectant composition for use in disinfecting hands, instruments, linen, utensils, rooms, stables and tools. The disinfectant composition includes dichlorobenzyl alcohol, a dissolving agent for the dichlorobenzyl alcohol and water. The dissolving agent can include monovalent or polyvalent alcohols such as ethyl alcohol, isopropyl alcohol, glycol, polyglycol and glycerol.

First, the Applicants submit that patentable weight should be given to the term "shaving", which appears in the preamble of claims 1-5. When the preamble gives meaning and life to the claim, the preamble should be construed as giving patentable weight to the claim. See MPEP 2111.02. The term "shaving composition" certainly breathes meaning into claim 1 in the present application. The term "shaving" alone limits the compositions to, for example, those which can be applied to the skin. Accordingly, to omit the term as one that does not provide any meaning to the claim is improper.

With regards to the '153 and '782 references, neither reference teaches or suggests use of dichlorobenzyl alcohol and an inert volatile liquid in a shaving composition as disclosed in claim 1 of the present application. Instead the '153 reference teaches formulations for disinfection and cleansing of human skin and hands. As the Examiner admits, none of the formulations of the '153 reference describe both dichlorobenzyl alcohol and an inert volatile liquid in the same formulation. Likewise, the '782 reference does not teach or suggest use of dichlorobenzyl alcohol in a shaving composition at all. Instead, the '782 reference relates to a disinfectant composition for destroying tubercle bacteria on hands, instruments, linen, utensils, rooms, stables and tools. Thus, the '153 and '782 references, individually or in combination fail to teach or suggest the composition recited in claim 1 of the present application.

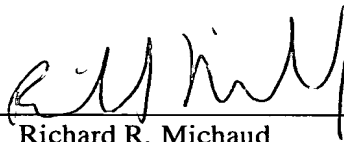
Summary

The Applicants have addressed each of the Examiner's objections and traversed all of the rejections of the outstanding Office Action through the above remarks. In light of the above, it is respectfully requested that claims 1-5 be allowed to issue as a patent.

A check in the amount of \$120.00 is enclosed to cover the one-month extension fee. If any further charges are incurred with respect to this Amendment, they may be charged to Deposit Account No. 503342 maintained by Applicants' attorneys. If the Examiner has any questions, please feel free to contact the Attorney of Record at the contact information provided below.

Respectfully submitted,

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